

REMARKS**Status of Claims**

The Office Action mailed June 14, 2005 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-25 were pending in the application. Claims 1, 24, and 25 have been amended and no claims have been cancelled or newly added. Therefore, claims 1-25 are pending in the application and are submitted for reconsideration. Applicant respectfully requests entry of and reconsideration based on the instant amendment and reply because it is believed to place the application in condition for allowance. Furthermore, applicant submits that the instant claim amendments more clearly define features that were argued earlier so that these features should have been already considered by the examiner.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Prior Art Rejection

In the Office Action, claims 1, 4-6, 10-15, 24, and 25 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 6,678,867 to Fong et al. (hereafter "Fong"). Claims 2, 3, 7-9, and 16-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fong in view of U.S. patent application 2002/0026461 to Kutay et al. (hereafter "Kutay"). Applicant respectfully traverses these rejections for at least the following reasons.

Each of the independent claims 1, 24, and 25 recite a method, system, or program product that, *inter alia*, receiving a XML environment and automatically creating a target model and source model by only using predetermined rules (and the received XML environment). Such a feature is not disclosed or suggested by the applied prior art.

As discussed in the earlier reply, such automatic creation of a target model and a source model (as a part of the mapping process) is disclosed in the specification at, for example, pages 9-16. For example, for an Inbound XML map, (1) the predetermined rules for creating the source XML model is disclosed in page 9, line 13 to page 10, line 25 and the (2) the predetermined rules for creating the target flat-file model is disclosed in page 10, line 26 to page 12, line 8. Likewise, for an outbound XML map, (1) the predetermined rules for the

source flat-file model as disclosed in page 13, line 15 to page 14, line 19 and (2) the predetermined rules for the target XML model is disclosed in page 14, line 20 to page 16, line 10. Therefore, the pending claims require the automated creation of the XML map (including the source model, the target model, and the business rules) by only using predetermined rules. That is, the map is created automatically based on predetermined rules and the only input from the user relates to *what* is being mapped (and not the mapping process itself), i.e., specifying the particular XML environment and the direction of mapping, as shown for example in figure 5 of the specification.

In sharp contrast, Fong discloses that the mapping process itself is interactive. See Abstract (“...which allows a user to interactively *define* the mapping”) and the Summary of Invention section (col. 2, line 60-61) of Fong. The portions of Fong cited in the office action also disclose exactly this interactive mapping process. For example, Fong discloses that its invention “accepts interactive user input, to be processed by the map creator, for making plural changes to any of the component mapping values the user desires. See col. 3, lines 65-67 of Fong. Therefore, Fong discloses that the mapping process itself is an interactive process which clearly does not disclose the claimed mapping process that uses *only* predetermined rules (and the input XML environment).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, (Fed. Cir. 1989). See MPEP §2131. Therefore, in order for a reference to be utilized as an anticipatory reference under the provisions of 35 U.S.C. § 102, the reference must disclose each and every claimed element. This is certainly not the case here, and thus the Sec. 102 rejection as to the pending independent claims must be withdrawn.

The dependent claims are also in condition for allowance for at least the same reasons, as discussed above, as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

Comments of Paragraph 8 ("Response to Arguments")

In paragraph 8, the office action states that pages 9-16 of the specification discloses that user may have the option to generate the source and target models automatically or not. This statement is somewhat irrelevant, since it is well known that in the patent process, the specification may disclose features or embodiments that are not claimed. Accordingly, when the pending claims clearly recite the *automatic* generation of the source and target models then citing to additional unclaimed features in the specification is an improper basis to interpret the claims.

In view of the foregoing amendments and remarks, applicant respectfully submit that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicant hereby petition for any needed extension of time.

Respectfully submitted,

Date September 13, 2005

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 672-5414

Facsimile: (202) 672-5399

By Aaron C. Chatterjee

William T. Ellis

Registration No. 26,874

Aaron C. Chatterjee

Registration No. 41,398

Attorneys for Applicant